

Remarks

Claims 1-14 and 18-19 are currently pending in the above-captioned matter. By this amendment, no claims have been amended, no new claims have been added, and no new matter has been added.

The Examiner's withdrawal of the rejection of claims 1-14 based on WO98/23789 is respectfully acknowledged.

35 U.S.C. §112 Rejections

Claims 1-14 and 18-19 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement for use of the word "about" in claim 1. Support for the concentrations of (A) and (B) is found in the specification at page 6, line 8-15 and page 8, line 2-10. Support for the term "about" as applied to the numbers recited in the specification is also found in the specification, as follows:

Except in the claims and the operating examples, or where otherwise expressly indicated, **all numerical quantities in this description indicating amounts of material or conditions of reaction and/or use are to be understood as modified by the word "about" in describing the broadest scope of the invention.** Specification, page 3, line 13-17.

Based on the foregoing, Applicant submits that the requirements of 35 U.S.C. §112, first paragraph, have been met and respectfully requests that this rejection be withdrawn.

35 U.S.C. §103 Rejections

Claims 1-14 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/12655 to Hacias (the '655 publication), described as corresponding to US Patent No. 6,472,352 (the '352 patent) in view of WO 98/23789 to Hacias (the '789 publication), described as corresponding to US Patent No. 6,068,710 to Hacias, and further in view of US Patent No. 4,289,547 to King et al. (the '547 patent). This rejection is traversed.

The '655 publication is directed to aqueous liquid lubricant compositions for

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forming a coating containing organic binder material on metal surfaces, see Col. 1, line 9-11. There is no teaching or suggestion of the composition being reactive with the metal surfaces. The compositions of the '655 publication do not form conversion coatings.

In contrast, Applicant's compositions, which contain phosphate, are reactive with the metal substrate, thereby forming a conversion coating that contains both conversion coating attributes and lubricant. This difference in how the composition interacts with the substrate shows the importance of the presence of phosphate in the coating composition. The presence of phosphate fundamentally alters the chemistry between the coating composition and metal surfaces.

The Patent Office admits that there is no teaching or suggestion of using phosphate in the coatings of the '655 publication, see Official Action dated January 25, 2008, page 4, line 5. This is an important difference between Applicant's invention and the '655 publication.

More important is the fact that the '655 publication teaches away from using phosphates where it recites:

Many aqueous liquid compositions that form coatings on metal surfaces that protect the metal surface while it is being cold worked are known. The previously most effective ones have generally been zinc, calcium, and/or sodium soaps applied over a preceding heavy phosphate conversion coating on steel substrates or over a complex calcium aluminate conversion coating on aluminum substrates. However, this combination is environmentally disadvantageous, especially when used over phosphate coatings, because the liquid compositions used to form phosphate coatings generally contain some types of metal ions, such as those of zinc, nickel, manganese, and/or the like, that are regarded as polluting, and the phosphate ions themselves, which are required in phosphate conversion coating forming liquid compositions, are environmentally undesirable in waste waters because of their promotion of eutrophication of natural bodies of water.

Thus, the primary reference relied upon by the Patent Office discourages use of the very component that the Patent Office seeks to add to the ethoxylated alcohol

containing composition of the '655 publication.

The '789 publication is directed to an aqueous liquid treatment composition comprising water and a combination of: (A) dissolved orthoboric acid; and (B) dissolved condensed phosphoric acids and anions derivable by neutralization thereof. See WO 98/23789, pg. 2, Summary of the Invention.

As discussed in the previous response, ethoxylated alcohol containing compositions are not taught or suggested as useful to mix with the phosphate containing component (B). In a separate section of the publication, the '789 publication teaches that the ethoxylated alcohol is applied in a separate step after the coating containing (A) and (B) is applied and dried:

Irrespective of whether or not a wet coating formed by a process according to the invention has been rinsed or not before being dried, the dried coating may be, and usually preferably is, coated with additional lubricant materials known per se in the art before being cold worked. A wide variety of oils and greases, along with other materials, are known for this purpose. A particularly preferred supplemental lubricant of this type includes as a principal constituent ethoxylated straight chain aliphatic alcohol molecules,... WO 98/23789, page 8, lines 18-23 (emphasis added).

The '789 publication also teaches away from the combination of phosphate and ethoxylated alcohol in a single composition. Specifically, in the Examples, the '789 publication teaches that adding ethoxylated alcohol to its compositions results in precipitation of the bath, an undesirable result, see Example 3.3.

Thus both the primary and secondary references teach away from the combination proposed by the Patent Office, and the '789 publication provides data in the form of Example 3.3. showing that this combination results in undesirable bath precipitation. The general disclosure of the '547 patent does not recognize nor address the problem of precipitation in the bath when combining ethoxylated alcohols with phosphates and would not have provided one of skill in the art at the time the invention was made with motivation to make the claimed combination in the face of plain teachings in both the primary and secondary reference that the presence of both

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phosphate and ethoxylated alcohols in the same bath was undesirable. Accordingly, the invention recited in claims 1-14 and 18-19 would not have been obvious at the time the invention was made in view of the cited art. The 35 U.S.C. 103(a) rejection of Claims 1-14 and 18-19 should be withdrawn.

Conclusion

Applicants request reconsideration in view of the amendments and remarks contained herein. Applicants submit that the claims are in condition for allowance and a notice to that effect is respectfully requested. Should the Examiner have any questions regarding this paper, please contact the undersigned

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